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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/191,277	11/12/1998	TORU MATSUDA	74451.P093	8448

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EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
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2155

28

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/191,277

Applicant(s)

MATSUDA ET AL.

Examiner

Philip B Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,12-21,23-28 and 31-46 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-7,12-21,23-28 and 31-46 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Response to Request for Reconsideration

1. This office action is in response to the amendment filed on 8/14/2003. Claims 1, 12, 21, 26 and 31 have been amended. Claims 8-11, 22 and 29-30 have been previously canceled. Therefore, claims 1-7, 12-21, 23-28 and 31-46 are presented for further examination.

Response to Arguments

2. Applicants have amended the claims to overcome the informal claim objections and thus objections to claims 5-7, 13, 24, 25 and 28 are withdrawn.

3. Applicants' arguments have been fully considered but they are not persuasive because of the following reasons : Lister teaches a method for providing dynamic configuration comprising requesting, with a local device, configuration services from a remote device coupled to the network in response to connecting the local device to the network, providing configuration services to one or more remote devices of the network if the response to the configuration information request is not received by the local device from the remote device within a predetermined period of time or if the response to said configuration information request is received by the local device from said remote device within the predetermined period of time, and receiving configuration services from said remote device with the local device as a client device. For example, providing automatic configuration and establishing and monitoring connections of clients to the server through the network [see Abstract and Fig. 1, and Col. 3, Line 39 - Col. 4, Line 67]. Lister does not explicitly teach operating the local device as a configuration

services server to provide configuration services and operating the local device as a configuration service client to receive configuration services. However, the use of operating as a list manager to maintain a list of device addresses and operating as a slave to provide a device address is well-known in the art as disclosed by Danknick [see Abstract and Fig. 5B and Col. 1, Line 41 – Col. 2, Lines 41]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the local device either as a configuration service server or as a configuration service client because it would have provided an advantages of selectively configuration service such as maintaining a list of device addresses by providing and receiving device addresses. In addition, Lister does not explicitly teach providing the configuration services, with the local device, to one or more remote devices of the network if the local device has a higher priority than the remote device. However, the task of comparing the priority between one device to another is well-known in the art as disclosed by Rangaraian [see Abstract]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to determine the priority of devices connected to the network in order to identify the appropriate states of devices in the network before making decision of whether or not necessarily to provide configuration service.

Moreover, Lister further teaches a method comprising automatically assigning an address to a local device on the network, automatically assigning a network name to the local device on the network, automatically supplying user and group information across the network, and automatically determining service capability of the device on the network. For example, automatic configuration of network addresses and names, and

identifying specific resources that are shared between clients and server, and determining device on the network for which is assigned to respond to network-file-services protocol requests [see Col. 4, Line 14 - Col. 5, Line 39 and Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64], including whether the local device is capable of providing configuration services to one or more remote devices of the network, and operating the local device as a client device to the remote device. For example, providing automatic configuration and establishing and monitoring connections of clients to the server through the network [see Abstract and Fig. 1, and Col. 3, Line 39 - Col. 4, Line 67]. Moreover, Lister further teaches maintaining a DRS database to track a client list, a proxy site, an alias name and a source server in an automatic operating mode [see Col. 9, Lines 29-65]. Clearly, Lister teaches automatically configuring network in which network services are identified and service use data are collected and provided in an environment of various servers and clients [see Title, Abstract and Col. 4, Lines 15-57]. In addition, the task of comparing the priority between one device to another is well-known in the art as provided in Rangaraian et al, U.S. Pat. No. 5,828,830. As a result, Lister and other cited references do disclose a method for configuring device on the network as broadly claimed by the applicants.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir.

1986). Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as shown in the following section.

Therefore, the examiner asserts that Lister teaches or suggests the subject matter broadly recited in independent claims. Claims 2-7, 13-20, 23-25, and 27-28 are also rejected at least by virtue of their dependency on independent claims and by other reasons set forth above. Accordingly, claims 1-7, 12-21, 23-28 and 31-46 are respectfully rejected as shown below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 12 recites the limitation "...of said local device..." in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-7, 21, 23-25 and 31-37 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lister et al (Hereafter, Lister), U.S. Pat. No. 6,167,446 in view of Danknick, U.S. Pat. No. 6,021,429 and further in view of Rangaraian et al (Hereafter, Rangaraian), U.S. Pat. No. 5,828,830.

Regarding claim 1, Lister teaches a method for providing dynamic configuration comprising requesting, with a local device, configuration services from a remote device coupled to the network in response to connecting the local device to the network, providing configuration services to one or more remote devices of the network if the response to the configuration information request is not received by the local device from the remote device within a predetermined period of time or if the response to said configuration information request is received by the local device from said remote device within the predetermined period of time, and receiving configuration services from said remote device with the local device as a client device (i.e., providing automatic configuration and establishing and monitoring connections of clients to the server through the network) [see Abstract and Fig. 1, and Col. 3, Line 39 - Col. 4, Line 67]. Lister does not explicitly teach operating the local device as a configuration

services server to provide configuration services and operating the local device as a configuration service client to receive configuration services. However, the use of operating as a list manager to maintain a list of device addresses and operating as a slave to provide a device address is well-known in the art as disclosed by Danknick [see Abstract and Fig. 5B and Col. 1, Line 41 – Col. 2, Lines 41]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the local device either as a configuration service server or as a configuration service client because it would have provided an advantages of selectively configuration service such as maintaining a list of device addresses by providing and receiving device addresses. In addition, Lister does not explicitly teach providing the configuration services, with the local device, to one or more remote devices of the network if the local device has a higher priority than the remote device. However, the task of comparing the priority between one device to another is well-known in the art as disclosed by Rangaraian [see Abstract]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to determine the priority of devices connected to the network in order to identify the appropriate states of devices in the network before making decision of whether or not necessarily to provide configuration service.

Regarding claim 2, Lister further teaches providing the configuration services with the local device comprises determining a first network address, assigning a second network address, assigning a network name, correlating the first network address, the second network address, and the network name, and recording the correlated first

network address, the correlated second network address and the correlated network name in a table (i.e., automatic configuration of network addresses and names) [see Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64].

Regarding claim 3, Lister further teaches a media access control (MAC) address [see Col. 18, Lines 50-54].

Regarding claim 4, Lister further teaches an Internet Protocol (IP) address [see Col. 17, Lines 22-26].

Regarding claim 5, Lister further teaches assigning the network name comprises detecting a network name conflict, resolving the network name conflict, and recording a code in the table to indicate the network name conflict [see Abstract and Col. 4, Lines 45-57 and Col. 8, lines 45-53].

Regarding claim 6, Lister further teaches the network name is suggested by the local device [see Abstract].

Regarding claim 7, Lister further teaches the predetermined period of time is varied [see Col. 10, Lines 47-63].

Claim 21 is rejected under the same rationale set forth above to claim 1.

Regarding claim 23, Lister further teaches the device configured to automatically assigning a network address, assigning a network name, correlate the network address with the network name and recording the network address and network name in a table (i.e., automatic configuration of network addresses and names, and identifying specific resources that are shared between clients and server, and determining device on the network for which is assigned to respond to network-file-service s protocol requests) [see Col. 4, Line 14 - Col. 5, Line 39 and Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64].

Claim 24 is rejected under the same rationale set forth above to combination of claims 3 and 5.

Claim 25 is rejected under the same rationale set forth above to claim 4.

Claim 31 is rejected under the same rationale set forth above to claim 1.

Claims 32-37 are rejected under the same rationale set forth above to claims 2-7, respectively.

8. Claims 12-20, 26-28 and 38-46 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lister et al (Hereafter, Lister), U.S. Pat. No. 6,167,446 in view of Rangaraian et al (Hereafter, Rangaraian), U.S. Pat. No. 5,828,830.

Regarding claim 12, Lister teaches a method comprising determining service capability of the device on the network (i.e., automatic configuration of network addresses and names, and identifying specific resources that are shared between

clients and server, and determining device on the network for which is assigned to respond to network-file-service s protocol requests) [see Col. 4, Line 14 - Col. 5, Line 39 and Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64], including whether the local device is capable of providing configuration services to one or more remote devices of the network, and operating the local device as a client device to receive configuration services from the remote device (i.e., providing automatic configuration and establishing and monitoring connections of clients to the server through the network) [see Abstract and Fig. 1, and Col. 3, Line 39 - Col. 4, Line 67]. Lister does not explicitly teach providing the configuration services to one or more devices of the network if the local device has a higher priority than the remote device. However, the task of comparing the priority between one device to another is well-known in the art as disclosed by Rangaraian [see Abstract]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to determine the priority of devices connected to the network in order to identify the appropriate states of devices in the network before making decision of whether or not necessarily to provide configuration service.

Regarding claim 13, Lister further teaches supplying user and group information comprises detecting when the local device is connected to said network, sending a first user and group list to the local device in response to the local device connecting to the network, receiving a more recent user and group list from local device, updating the user and group information to reflect the more recent user and group list, and

propagating the updated user and group information throughout the network (i.e., providing automatic configuration and establishing and monitoring connections of clients to the server through the network) [see Abstract and Fig. 1, and Col. 3, Line 39 - Col. 4, Line 67]. Lister does not explicitly teach comparing the first user and group list with a second user and group list resident on the device and determining whether the first user and group list or the second user and group list is more recent. However, the task of comparing the priority between one device to another is well-known in the art as disclosed by Rangaraian [see Abstract]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to determine the priority of devices connected to the network for the same reasons set forth above to claim 1.

Regarding claims 14-16, Lister does not explicitly teach a time-stamp is used to determine whether the first user and group list or the second user and group list is more recent, updating the user and group information comprises recording the more recent user and group list in clear text, updating the user and group information comprises encrypting the user and group information prior to transmission across the network. However, the use of time-stamp and encryption is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement time-stamp for determining the status of data changing with time and to provide encryption process in order to protect data routing through the network.

Regarding claim 17, Lister further teaches correlating the network address and the network name, and storing the correlated network address and the correlated network name in a table (i.e., automatic configuration of network addresses and names) [see Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64].

Regarding claim 18, Lister further teaches the network name is suggested by the local device [see Abstract].

Regarding claim 19, Lister further teaches HyperText Transfer Protocol (HTTP) is used to exchange information [see Col. 6, Lines 59-67].

Regarding claim 20, Lister does not explicitly teach the Service Location Protocol (SLP) is used to exchange information. However, the use of service location protocol is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement service location protocol because it would have enabled the users to locate servers and other network devices connected to the network.

Claim 26 is rejected under the same rationale set forth above to claim 12. In addition, Lister further teaches assigning an address to a local device on the network, assigning a network name to the local device on the network, supplying user and group information across the network, and determining service capability of the device on the

network (i.e., automatic configuration of network addresses and names, and identifying specific resources that are shared between clients and server, and determining device on the network for which is assigned to respond to network-file-service s protocol requests) [see Col. 4, Line 14 - Col. 5, Line 39 and Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64].

Claims 27-28 are rejected under the same rationale set forth above to combination of claims 14-16.

Claim 38 is rejected under the same rationale set forth above to claim 12. In addition, Lister further teaches assigning an address to a local device on the network, assigning a network name to the local device on the network, supplying user and group information across the network, and determining service capability of the device on the network (i.e., automatic configuration of network addresses and names, and identifying specific resources that are shared between clients and server, and determining device on the network for which is assigned to respond to network-file-service s protocol requests) [see Col. 4, Line 14 - Col. 5, Line 39 and Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64].

Claims 39-46 are rejected under the same rationale set forth above to claims 13-20, respectively.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (703) 308-6662.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PST
Philip Tran
Art Unit 2155
Oct 29, 2003


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER